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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,963	10/06/2003	Gene Mason	MASIMO.353A	3580
20995	7590	12/23/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			KREMER, MATTHEW J	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3736	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/679,963	MASON, GENE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew J Kremer	3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Applicants had requested the Examiner to indicate acknowledgement of a claim for domestic priority under 35 U.S.C. 119(e) in the Amendment filed on 9/1/2004. If Applicants wish to claim the benefit of an earlier application, Applicants must meet all of the requirements set forth in the appropriate statutes and rule (35 U.S.C. 119)(a)-(d), (f), 35 USC 119(e), 120, 121, and/or 365 and 35 CFR 1.55 and/or 37 CFR 1.78). See MPEP 201.11 and 201.15 for more information on the requirements. When an applicant submits a benefit or priority claim, the Office provides an acknowledgment on the official filing receipt. The Applicant may also check PAIR. It is not required for the Examiner to provide another acknowledgment.

### ***Election/Restrictions***

2. Newly submitted claims 19-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: original claims 1-10 were directed to a first invention of a device for positioning a reflective optical probe to a measurement site, which is classified in class 600/344. New claims 19-23 are directed to a second invention of a pulse oximetry system, which is classified in 600/323.
3. The inventions are distinct, each from the other because of the following reasons:

inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as pulse oximeter that is attached in a number of ways including a finger clip. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 11 and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,748,254 to O'Neil et al. (O'Neil). O'Neil teaches an emitter 11, a detector 7, a probe housing that includes layers 1 and 3 and a first positioning member in the form of a tab, protruding lenses 4, a protruding optical barrier 6, and an attachment mechanism in the form of layers 8-10. (Fig. 1 of O'Neil).

7. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,830,137 to Scharf. Scharf teaches an optical probe that includes emitters 13b and 15b; a detector 26; a probe housing 82 with a first positioning member 96; a protruding optical barrier 90; and an attachment mechanism in the form of a strap that mates with first positioning member. (Fig. 3 and column 9, lines 18-41 of Scharf). Scharf teaches that face pieces 16, 18, and 91 are shaped to form lenses. (column 8, lines 59-62 of Scharf).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,830,137 to Scharf in view of Patent 4,802,485 to Bowers et al. (Bowers). Scharf teaches a strap, which mates with a first positioning member. (Fig. 3 and column

9, lines 18-41 of Scharf). Scharf further teaches that the device is used on the forehead. (Abstract of Scharf). Scharf does not teach the particulars of the strap for the forehead. Bowers teaches a headband (Fig. 3 of Bowers) that would fulfill the requirements of providing a strap for the forehead as set forth by Scharf and ensure that the sensor is placed against the forehead. (column 4, lines 28-39 of Bowers). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the headband of Bowers in the invention of Scharf since Scharf teaches the use of a strap to be used on the forehead and Bowers teaches one such band and the headband of Bowers ensures that the sensor is placed against the forehead. In regard to claim 12, the combination teaches a biasing member 52. (Fig. 3 of Bowers). In regard to claim 14, attachment device 40 is a headband. In regard to claims 15-16, ruler-like indicia are disclosed (reference number 44 in Fig. 3 of Bowers).

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 11-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 571-272-4727. The examiner can normally be reached on Mon. through Fri. between 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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